

REMARKS

This application has been reviewed in light of the Office Action dated December 1, 2006. Claims 1, 2, 19, 21, 23, and 51-54 are presented for examination, of which Claims 1, 2, 19, 21, and 23 are in independent form. Claims 3-18, 20, 22, and 24-50 have been cancelled without prejudice or disclaimer of subject matter, and will not be mentioned further. Claims 51-54 have been added to provide Applicant with a more complete scope of protection. Claims 1, 2, 19, 21, and 23 have been amended to define still more clearly what Applicant regards as his invention. Favorable reconsideration is requested.

Claims 1, 2, 19, 21, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,978,013 (*Jones*) in view of U.S. Patent 6,588,012 (*Tanaka*).

Applicants submit that those claims, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

The present invention relates to a digital broadcast receiving apparatus in which a digital broadcast program and a partial content included in the program are set in advance. A feature of the present invention is to judge whether the received digital broadcast of the set program includes information related to the set partial content and to extract and print the information, when the information is included. See, e.g., page 16, lines 17-24, and Fig. 6 of the present application.^{1/}

^{1/} It is of course to be understood that the claim scope is not limited by the details of this or any other particular embodiment that may be referred to.

For example, in a case where the digital broadcast program is a cooking program and a recipe is provided in the cooking program as part of the content of the program, the recipe can be printed out. Notably, it is an aspect of the invention, as currently claimed, to set or designate the printing of the partial content in advance. Consequently, a user does not need to operate a receiving apparatus for printing while receiving the digital broadcast in order to obtain the printed information.

The aspect of the present invention set forth in Claim 1 is a digital broadcast receiving apparatus that includes means for setting a digital broadcast program and a print reservation of partial content which is provided in the program and can be displayed on a display when the program plays, in advance. The apparatus also includes means for receiving a digital broadcast of the program, means for extracting the partial content, and judging means for judging whether or not extracted partial content includes an information part print-output of which is not permitted. Additionally, the apparatus includes printing means for print-outputting the extracted partial content, but which print-output only that portion of the extracted partial content other than the information part, when the judging means judge that the extracted partial content includes the information part.

Among other notable features of Claim 1 are (1) the means for setting a digital broadcast program and a print reservation of partial content which is provided in the program and can be displayed on a display when the program plays, in advance; (2) the means for judging whether or not extracted partial content includes an information part print-output of which is not permitted; and (3) the printing means print-output only that portion of the extracted partial content other than the information part when the judging means judge that the extracted partial content includes the information part. An important

benefit of these features is that when content to be displayed includes an information part that is not allowed to be printed, a user will be prevented from printing the information part. Thus, the apparatus of Claim 1 prevents only the printing of a print-prohibited part. The user can still print the non-prohibited part of the extracted content.

The *Jones* system, as understood by Applicant, is for printing coupons from a broadcaster, and permits a user to print a coupon when a broadcaster gives permission, and only during the broadcast, not in advance. Thus, printing the entire coupon is either permitted or prohibited, and if permitted, is only possible while the broadcast is actually being aired. Applicant submits that nothing in *Jones* would suggest prohibiting the printing of just part of the content, nor reserving printing content in advance, as is recited in Claim 1.

The Office Action states that “it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the digital broadcast receiving apparatus disclosed by Jones to perform a means for setting a digital broadcast program and partial contents provided in the program, in advance, as taught by Tanaka....” Applicant respectfully disagrees that there is sufficient motivation to combine the teachings of *Jones* with *Tanaka*. In fact, *Jones* specifically teaches against allowing a user to record coupons (content) in advance of viewing them, in order to prevent fraud from unlimited duplication. (*Jones*, column 1, lines 63-65; column 5, lines 28 and 29, and lines 47-49). Applicant notes the Examiner’s analysis that one of ordinary skill would have found the proposed combination of references obvious because of . Since *Jones* emphatically teaches that it is a bad idea to permit the user to record coupons before viewing them, however, Applicant submits that the proposed combination would require the person of ordinary skill

to ignore a feature that is apparently a key part of what *Jones* was specifically aiming at (see column 1, lines 60-65, complaining that a system which permits the user to record the coupon while away from the television both encourages multiple printings of a coupon, and also fails to encourage the consumer to watch the program). Applicant notes that the MPEP teaches that a proposed combination that involves ignoring the teachings of one of the references is improper:

“If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

‘Although statements limiting the function or capability of a prior art device require fair consideration, simplicity of the prior art is rarely a characteristic that weighs against obviousness of a more complicated device with added function.’ *In re Dance*, 160 F.3d 1339, 1344, 48 USPQ2d 1635, 1638 (Fed. Cir. 1998) (Court held that claimed catheter for removing obstruction in blood vessels would have been obvious in view of a first reference which taught all of the claimed elements except for a ‘means for recovering fluid and debris’ in combination with a second reference describing a catheter including that means. The court agreed that the first reference, which stressed simplicity of structure and taught emulsification of the debris, did not teach away from the addition of a channel for the recovery of the debris.). [Emphasis added]”
MPEP § 2143.01. V.

Applicant submits that the proposed combination of *Tanaka* with *Jones* is precisely such a combination, as it would defeat one of the main fraud prevention features of the *Jones* system.

The *Tanaka* system, as understood by Applicant, relates to a combination terminal unit that receives various types of media signals, such as telephone, radio, fax, and cable television. As shown in Figs. 14 and 15, the user may perform a search of the various types of media by entering a search term. The results of the search are displayed in a list (Fig. 15), from which the user may select a desired program or other information to be retrieved. *Tanaka* further discusses a scheduler that establishes a line connection to a predetermined information entity at a time designated by the input device.

Thus, in the *Tanaka* system, a program is located in a search according to a topic designated by a user, and the user can have the system record that program if it is a TV program or a radio program (see e.g., Figs. 11B and 12B, and col.12, lines 6-13 and 29-36). The topic indicates the whole program and does not indicate a partial content provided in a program.

The Office Action cites *Tanaka* for the feature of setting a digital broadcast program, and partial contents provided in the program, in advance for future viewing. However, Applicant submits that nothing has been found in *Tanaka* that would teach setting a digital broadcast program and a print reservation of a partial content which is provided in the program and can be displayed on a display when the program plays, in advance, as recited in Claim 1.

It is respectfully submitted that nothing in either *Jones* or *Tanaka*, whether considered separately or in any permissible combination (if any), would teach or suggest

(1) means for setting a digital broadcast program and a print reservation of partial content which is provided in the program and can be displayed on a display when the program plays, in advance; (2) means for judging whether or not extracted partial content includes an information part print-output of which is not permitted; and (3) printing means print-output only that portion of the extracted partial content other than the information part when the judging means judge that the extracted partial content includes the information part, as recited in Claim 1.

Accordingly, withdrawal of the rejection of Claim 1 is respectfully requested.

The other independent claims are each a method or a computer memory medium claim corresponding to apparatus Claim 1, or are directed to an apparatus having features substantially like those discussed above in connection with Claim 1, or to a system including such an apparatus. Accordingly, each of the independent claims is thought to be allowable for at least the same reasons as discussed above in connection with Claim 1.

A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. All of the independent claims are therefore believed patentable over the art of record.

The other claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Because each dependent claim also is deemed to define an additional aspect of the invention, individual consideration of the patentability of each claim on its own merits is respectfully requested.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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